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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,881	06/06/2006	Satoshi Niwano	2006_0823A	3935
52349 7590 03/08/2010 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
RAVETTI, DANTE				
ART UNIT		PAPER NUMBER		
3685				
NOTIFICATION DATE		DELIVERY MODE		
03/08/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/581,881

**Applicant(s)**

NIWANO ET AL.

**Examiner**

DANTE RAVETTI

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. This communication is in response to the amended Application No. 10/581,881 filed on 12 February 2009.
2. Claims 24-34 are currently pending and have been fully examined.
3. Claims 1-23 have been cancelled by the Applicant.
4. For the purpose of applying the prior art, PreGrant Publications will be referred to using a four digit number within square brackets, e.g. [0001].

### ***Response to Applicant's Remarks/Amendments***

5. Applicant's response, filed on 14 February 2009 have been fully considered, but are moot in light of new grounds of rejection.

In light of Applicant's choice to pursue system claims, Applicants are also reminded that functional recitations using the word "for," "adapted to," "configured to," or other functional terms (e.g. see claim 24 which recites "first license generation unit **operable to** generate, in a first format...a modification detection information generation unit **operable to** generate...information receiving unit **operable to** receive ...") have been considered but are given little patentable weight<sup>1</sup> because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However a recitation of the intended use in a system claim must result in a structural difference between the

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<sup>1</sup> See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401,404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

claimed system and the prior art in order to patentably distinguish the claimed system from the prior art. Claims 27-29, 32 and 34 contains similar language found in claim 24.

As to claim 24, Applicant recites, "... a use unit operable to use the content according to the first license in the case where the judgment unit judges that no modification is made...depending on a transmission path...." The MPEP interprets claim limitations that contain "if, may, might, can, when and could" statement(s), as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.<sup>2</sup> Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.<sup>3</sup>

As to claim 29, Applicant recites, "...in the case where no modification is detected, uses the content according to the first license...." The MPEP interprets claim limitations that contain "if, may, might, can, when and could" statement(s), as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.<sup>4</sup> Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.<sup>5</sup> Claim 32 contains similar language found in claim 29.

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<sup>2</sup> In re Johnston, 77 USPQ2d 1788 (Fed. Cir. 2006);

<sup>3</sup> MPEP §2106 II C;

<sup>4</sup> In re Johnston, 77 USPQ2d 1788 (Fed. Cir. 2006);

<sup>5</sup> MPEP §2106 II C;

As to claim 24, Applicant recites, "the second format being different from the first format...." However, this is example of descriptive material that does not receive patentable weight.

Clauses (e.g. whereby, thereby, wherein) that merely states the result of the limitation(s) of a claim(s) does not limit the scope of the claim(s).<sup>6</sup> Therefore, what comprises a users actions ("commencement action comprises a request...") and what the apparatus of claim 33, "wherein the second sending unit sends the second license to the terminal device via a transmission path different from the license management server," for example, will not limit the scope of the claim.

Examiner would also like to point out that Official Notice was used in the previous office action mailed on 14 August 2009 to indicate that the generation of a digital signature to detect modification in a license is a function of the digital signature. Also, that the generation of a digital signature to detect modification in a license is also old and well known in the art. Also, the transmission of a "digital signature" between servers and terminal device is old and well known in the art because this allows the "digital signature" to be relocated at different locations, to perform the function of verification, where so desired. Since Applicant has not attempted to traverse this Official Notice statement, Examiner is taking the common knowledge or well-known statement to be admitted prior art.

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<sup>6</sup> (Texas Instruments Inc. v. International Trade Commission 26, USPQ2d 1010 (Fed. Cir. 1993); Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); Amazon.com Inc. v. Barnesandnoble.com Inc., 57 USPQ2d 1747 (CAFC 2001); A (whereby/wherein) clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim;

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 24-28 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

As to claim 24, 35 USC §101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). The applicants claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC §101. The claims begin by discussing a **system**, but subsequently the claims then deal with the specifics of a **method** (e.g. the steps to perform) executed by the processing means (see rejection of claims under 35 USC §112, 2nd paragraph, for specific details regarding this issue).<sup>7</sup>

Claims 25-28 are also rejected for being dependent upon rejected claim 24.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 24-35 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter
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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claim 24, Applicant recites, "depending on a condition of a transmission path to the terminal device." However, Applicant's Specification seems to be silent the limitation of a "condition" of a transmission path. The appropriate correction is required. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

As to claim 25, Applicant recites, "where the modification detection information generation device determines that a frequency band of the transmission path is narrower than a frequency band...." However, Applicant's Specification recites:

[0133] Next, the license management server 100 generates license generation information for sending a license to the license relay server 110 based on the processing format license 510 generated in the loop A in the case where the transmission path to the terminal device 120 that is the sending destination of the license is narrow. To be more specific, the license management server 100 converts the license body 511 of the processing format license 510 into a format prescribed between the license relay server 110 and the license management server 100 that are sending destinations, adding the corresponding processing format signature 512 and the conversion format specification information 711 to each processing format, and generates the license generation information (step S125).

[0174] Note that, the above-mentioned embodiment explained that a license is distributed using a processing format in the case where the transmission band between the license management server 100 and the terminal device 120 is wide, and that the license is distributed in a transmission format via the license relay server 110 in the case where the transmission band is narrow, but, to be more specific, this may be previously determined in a contract for each terminal device 120. For example, a license is sent in a processing format to the terminal device 120 to which the license is distributed according to the contract from the license management server 100 using the communication circuit of a wide frequency band such as the Internet as a transmission path, in contrast, a license is sent in a processing format to the terminal device 120 to which the license is distributed according to the contract to the terminal device 120 using the communication path of a narrow frequency band, the communication path being, for example, Entitlement Control Message (ECM) of digital broadcasting. Also, for example, the license management server 100 may distribute the transmission format license via

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<sup>7</sup> §2173.05(p)II;

the license relay server 110 when the communication circuit is crowded by monitoring the degree of congestion of the communication circuit at a certain interval.

It does not appear clear, after reading Applicant's Specification, what, how or where the determination of a **size of path** is being performed (e.g. terminal device or license server). The "modification detection...device," as recited in claim 25, is thought to detect modifications in a license. It is not seen how the "modification detection...device" has a "**secondary**" purpose of detecting a "path size." The appropriate correction is required. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

As to claim 24, Applicant recites, "...by a malicious user." However, Applicant Specification seems to be silent the limitation of "malicious user." The appropriate correction is required. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

As to claim 24, it is considered to be a Hybrid claims since a person of ordinary skill in the art would recognize that the claim encompasses at least two statutory classes of invention. Evidence that Claim 24 recites a system includes: The preamble ("A content distribution system..."), dependent Claim 25, which begins "a content distribution system...." Evidence to support a construction that the claim is drawn to a method includes "...wherein, in the case where the modification detection information generation device determines that a frequency band of the transmission path is narrower than..." Because of the conflicting evidence, the claim is considered a Hybrid claim and the appropriate correction is required.

Claims 29 and 34-35 contains similar language or like deficiencies found in claim 24. The appropriate correction is required.

Claims 25-28 and 30-31 are also rejected for being dependent upon rejected claims 24 and 29. The appropriate correction is required.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 24-35 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 is rejected under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements.<sup>8</sup> The omitted elements are: unit or device determining the size of the transmission path to the terminal device. Therefore, the scope of the claim is not clear. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 25 recites the limitation "the modification detection information generation device" in claim 25. There is insufficient antecedent basis for this limitation in the claim. The Examiner believes Applicant means to recite, "modification detection information generation unit," not device. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

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<sup>8</sup> See MPEP § 2172.01.

The term "malicious user" in claim 24 is a relative term which renders the claim indefinite. The term "malicious user" is not defined by the claim, the Specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 29 and 34-35 contains similar language or like deficiencies found in claim 24. The appropriate correction is required.

As to claim 24, Applicant recites, " further operable to send the generated digital signature to the relay server, depending on a condition of a transmission path to the terminal device;" however, Examiner understands that the "transmission path" relates to the transmission of a license, not a digital signature. Therefore, the scope of the claim is not clear. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 29, 32 and 34-35 contain similar language or like deficiencies found in claim 24. The appropriate correction is required.

As to claim 24, Applicant recites, "...whose format is converted by the format conversion unit based on the digital signature;" however, the scope of the claim is not clear. Does the Applicant infer that the "digital signature" contains conversion information or does that Applicant infer that format conversion occurs after verification of the "digital signature" has been performed? One of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The appropriate correction is required.

Claims 29, 32 and 34-35 contain similar language or like deficiencies found in claim 24. The appropriate correction is required.

As to claim 26, Applicant recites, "...wherein the second license generation unit generates the second license whose data size is smaller than a data size of the first license generated in the first format." However, this is not afforded patentable weight because it is descriptive in nature.

As to claim 32, Applicant recites, "...a second sending unit operable...." However, Applicant's limitation seems to be absent a "first" sending unit. Therefore, the scope of the claim is not clear. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The appropriate correction is required.

Claims 25-28, 30-31 and 32 are also rejected for being dependent upon rejected claim 24, 29 and 32. The appropriate correction is required.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 24-35 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ganesan, (US 2002/0019814) ("Ganesan") and in view of Nakahara et al., (US 2003/0048907) ("Nakahara") and in further view of Sugahara et al., (US 2002/0136428) ("Sugahara").

**As to claims 24, 29 32, 34 and 35:**

Ganesan teaches substantially as claimed:

a license management server (Figures 1, 5A, 7);

a terminal device ([0009], [0010], [0014]-[0016], Figure 4);

a modification detection information generation unit operable to generate a digital signature for detecting a modification of the first license ([0013], [0121], [0137], [0150], [0158], [0173], Figure 1); and

further operable to send the generated digital signature to the...server ([0093], [0121], [0137], [0197], [0315]);

a judgment unit operable to judge presence or absence of the modification of the first license, by a malicious user ([0093], [0112], [0114], [0121], [0137]);

a use unit operable to use the content according to the first license in the case where the judgment unit judges that no modification is made ([0093], [0112], [0114], [0121], [0137]);

Ganesan does not expressly teach:

a relay server; and

wherein the license management server includes at least one processor programmed with the following units: a first license generation unit operable to generate, in a first format, a first license for controlling content use in the terminal device;

However, in regards to a "relay server," the cited prior art of Ganesan expressly teaches;

[0196] Importantly, it should be recognized that just as the root entity gave the license server 24 permission to issue licenses 16 by providing the certificate (CERT(PU-LS)S(PR-R)) to such license server 24, such license server 24 can provide a similar certificate to a second license server 24 (i.e., (CERT(PU-LS2)S(PR-LS1))), thereby allowing the second license server to also issue licenses 16. As should now be evident, a license 16 issued by the second license server would include a first certificate (CERT(PU-LS1)S(PR-R)) and a second certificate (CERT(PU-LS2)S(PR-LS1)). Likewise, such license 16 is validated by following the chain through the first and second certificates. Of course, additional links in the chain may be added and traversed.

Therefore, a predictable result of Ganesan would have been to employ the use of a "relay server" because the cited prior art of Ganesan teaches the use of a first and second license server that are associated to each other.<sup>9</sup>

However, in regards to *a first license generation unit operable to generate, in a first format, a first license for controlling content use in the terminal device*; the cited prior art of Ganesan expressly teaches;

[0196] Importantly, it should be recognized that just as the root entity gave the license server 24 permission to issue licenses 16 by providing the certificate (CERT(PU-LS)S(PR-R)) to such license server 24, such license server 24 can provide a similar certificate to a second license server 24 (i.e., (CERT(PU-LS2)S(PR-LS1))), thereby allowing the second license server to also issue licenses 16. As should now be evident, a license 16 issued by the second license server would include a first certificate (CERT(PU-LS1)S(PR-R)) and a second certificate (CERT(PU-LS2)S(PR-LS1)). Likewise, such license 16 is validated by following the chain through the first and second certificates. Of course, additional links in the chain may be added and traversed.

Therefore, a predictable result of Ganesan would have been to employ the use of *a first license generation unit operable to generate, in a first format, a first license for controlling content use in the terminal device* because the cited prior art of Ganesan teaches the use of a license containing a "first certificate" and a subsequent license containing a "first" and "second" certificate (e.g. different version) to the first license.<sup>10</sup>

Ganesan does not expressly teach:

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<sup>9</sup> Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007); Claims in application for patent on pocket insert for book are obvious in view of combination of two prior art patents, since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results, since neither applicant's specification nor her arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement.

<sup>10</sup> Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007); Claims in application for patent on pocket insert for book are obvious in view of combination of two prior art patents, since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results, since neither applicant's specification nor her arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than

whose format is converted by the format conversion unit based on the digital signature;

However, Office Notice is taken that *whose format is converted by the format conversion unit based on the digital signature*. For example, it is common to employ the use of a "digital signature" to be verified before a subsequent function is performed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Ganesan with the commonly recognized practice of *whose format is converted by the format conversion unit based on the digital signature*.

Ganesan discloses as discussed above; however, Ganesan does not expressly teach:

depending on a condition of a transmission path to the terminal device;

Nakahara does not expressly teach:

depending on a condition of a transmission path to the terminal device;

However, Nakahara expressly teaches:

[0118] The central processing section 12 transfers the generated format transmission requests Dfm1 and Dfm2 from the working area 13 to the communication section 14. The communication section 14 transmits the received format transmission requests Dfr1 and Dfr2 to the servers 21 and 31 via the transmission path N (step S315).

[0119] In the servers 21 and 31 (see FIG. 2 and FIG. 6), the communication sections 217 and 317 receive format transmission requests Dfr1 and Dfr2 from the transmission path N, and transfer and store them to the working areas 216 and 316 (step S316). After interpreting the stored format transmission requests Dfr1 and Dfr2, the central processing sections 215 and 315 retrieve the format data Dfm1 and Dfm2 stored in the format storage sections 218 and 318 onto the working areas 216 and 316 (step S317).

[0121] In the conversion apparatus Uc1 (see FIG. 9), the communication section 14 receives format data Dfm1 and Dfm2 from the transmission path N, and transfers and stores them to the working area 13 (step S319). Next, by referring to the format data Dfm1 and Dfm2, the central

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simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement.

processing section 12 converts the license information Dlc1 into the license information Dlc2 (step S320).

Therefore, a predictable result of Nakahara would have been to take in consideration of the "transmission path" to the terminal device because in the field of distributing content consideration of "transmission paths" are important for efficient and expedient lines for distributing content.<sup>11</sup> Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ganesan to include the features of Nakahara because in the field of distributing content, it is common to take into consideration "transmission paths" when distributing content to a terminal device.

Ganesan discloses as discussed above; however, Ganesan does not expressly teach:

a specification information receiving unit operable to receive an input of format specification information that is an instruction, to the terminal device, for converting a format of a second license to the first format;

second sending unit operable to send the generated second license to the terminal device;

However, Nakahara expressly teaches:

a specification information receiving unit operable to receive an input of format specification information that is an instruction, to the terminal device, for converting a format of a second license to the first format ([0002], [0011], [0126], [0139], [0157], Figures 1, 19A-G, 20-21, 24);

second sending unit operable to send the generated second license to the terminal device ([0002], [0011], [0126], [0139], [0157], Figures 1, 19A-G, 20-21, 24);

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<sup>11</sup> Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007); Claims in application for patent on pocket insert for book are obvious in view of combination of two prior art patents, since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results, since neither applicant's specification nor her arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ganesan to include the features of Nakahara because in the field of distributing content, it may be desirable to perform the function format conversion to meet the requirements of a plurality of different terminal devices being used by the user.

Ganesan discloses as discussed above; however, Ganesan does not expressly teach:

a specification information sending unit operable to send the received format specification information to the relay server;

Nakahara does not expressly teach:

a specification information sending unit operable to send the received format specification information to the relay server;

However, Nakahara does expressly teach:

Claim 5. The conversion apparatus according to claim 1, wherein the first and second terminal apparatuses are connected to first and second servers, the first and second servers at least generate the first and second license information and transmit the first and second license information to the first and second terminal apparatuses, and retain first and second format data representing formats of the first and second license information, the conversion apparatus further comprises a communication section for communicating with the first and second servers to receive the first and second format data, and the processing section converts the first license information stored in the working area into the second license information compatible with the second terminal apparatus in accordance with the first and second format data received by the communication section.

[0041] FIG. 1 is a block diagram illustrating a conversion apparatus Ucl according to a first embodiment of the present invention and the peripheral environments thereof. Referring to FIG. 1, the conversion apparatus Ucl is coupled to content distribution systems Scd1 and Scd2 via a wired or wireless transmission path N, in a manner capable of data communications. To the content distribution system Scd1, at least one server 21 and at least one terminal apparatus 22 are coupled in a manner capable of data communications via the transmission path N.

Therefore, the cited prior art of Nakahara teaches the use of "multiple" servers linked together to perform the operation of processing a request to perform a license format conversion. Therefore, a predictable result of Nakahara would have been to send format

specification information to the relay server because it teaches the use of multiple servers linked together, to perform the operation of license format conversion.<sup>12</sup>

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ganesan to include the features of Nakahara because in the field of distributing content, it may be desirable to perform the function format conversion to meet the requirements of a plurality of different terminal devices being used.

Ganesan discloses as discussed above; however, Ganesan does not expressly teach:

the terminal device includes at least one processor programmed with the following units: a format conversion unit operable to obtain the second license from the relay server and further operable to convert the format of the second license into the first format, according to the format specification information added to the second license;

However, Nakahara expressly teaches:

the terminal device includes at least one processor programmed with the following units: a format conversion unit operable to obtain the second license from the relay server and further operable to convert the format of the second license into the first format, according to the format specification information added to the second license (Claim 10, Figure 6);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ganesan to include the features of Nakahara because in the field of distributing content, it may be desirable to perform the function format conversion to meet the requirements of a plurality of different terminal devices being used.

The combination of Ganesan/Nakahara discloses as discussed above; however, the combination of Ganesan/Nakahara does not expressly disclose:

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<sup>12</sup> Id;

the relay server includes at least one processor programmed with the following units: a second license generation unit operable to generate, in a second format, a second license by adding, to the first license, the digital signature for detecting a modification of the first license, the second format being different from the first format, and further operable to add, to the generated second license, the format specification information received by the license management server;

Sugahara does not expressly teach:

the relay server includes at least one processor programmed with the following units: a second license generation unit operable to generate, in a second format, a second license by adding, to the first license, the digital signature for detecting a modification of the first license, the second format being different from the first format, and further operable to add, to the generated second license, the format specification information received by the license management server;

However, Sugahara expressly teaches:

An apparatus for embedding a watermark into contents data includes a parameter converting device for converting a parameter of first contents data to generate second contents data. A mixing device operates for embedding parameter information into the second contents data as watermark information. The parameter information represents a condition of the conversion of the parameter by the parameter converting device. The watermark information may include copyright information (Abstract).

Therefore, a predictable result of Sugahara would have been to employ the use of a *second license generation unit operable to generate, in a second format, a second license by adding, to the first license, the digital signature for detecting a modification of the first license, the second format being different from the first format, and further operable to add, to the generated second license, the format specification information received by the license management server* because Sugahara expressly teaches the use of a first contents data (e.g. first license) and the establishing of a second contents data (e.g. second license) after a watermark has been added to the first contents data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the combination of Ganesan/Nakahara to include the features of Sugahara because in the field of content distribution, with the use of a plurality of different terminal devices, it may be desirable to perform the function of format conversion.<sup>13</sup>

**As to claims 25 and 30:**

The combination of Ganesan/Nakahara/Sugahara discloses as discussed above;

however, the combination of Ganesan/Nakahara/Sugahara does not expressly teach:

wherein, in the case where the modification detection information generation device determines that a frequency band of the transmission path is narrower than a frequency band predetermined by a characteristic of the transmission path or a communication speed of the transmission path is slower than a communication speed predetermined by a characteristic of the transmission path, the modification detection information generation unit sends the generated digital signature to the relay server and instructs the relay server to generate the second license.

However, Office Notice is taken *that where the modification detection information generation device determines that a frequency band of the transmission path is narrower than a frequency band predetermined by a characteristic of the transmission path or a communication speed of the transmission path is slower than a communication speed predetermined by a characteristic of the transmission path, the modification detection information generation unit sends the generated digital signature to the relay server and instructs the relay server to generate the second license.*

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<sup>13</sup> Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007); Claims in application for patent on pocket insert for book are obvious in view of combination of two prior art patents, since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results, since neither applicant's specification nor her arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than

For example, in the field of content distribution, assigning a digital signature to only specific types of content makes it an efficient use of digital signatures. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Ganesan/Nakahara/Sugahara with the commonly recognized practice of *that where the modification detection information generation device determines that a frequency band of the transmission path is narrower than a frequency band predetermined by a characteristic of the transmission path or a communication speed of the transmission path is slower than a communication speed predetermined by a characteristic of the transmission path, the modification detection information generation unit sends the generated digital signature to the relay server and instructs the relay server to generate the second license.*

**As to claims 26 and 31:**

Ganesan discloses as discussed above; however, Ganesan does not expressly teach:

wherein the second license generation unit generates the second license whose data size is smaller than a data size of the first license generated in the first format.

However, Nakahara expressly teaches:

wherein the second license generation unit generates the second license whose data size is smaller than a data size of the first license generated in the first format (Figures 1, 17-18, 20-21);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ganesan to include the features of Nakahara because in the field of

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simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement.

distributing content, it may be desirable to generate multiple licenses to control different types of content, to be distributed through different transmission paths.

**As to claim 27:**

Ganesan discloses as discussed above; however, Ganesan does not expressly teach:

wherein the license management server includes a first sending unit operable to send the first license to the terminal device,

the relay server includes a second sending unit operable to send the second license to the terminal device via the transmission path different from the transmission path in the case of using the license management server, and

the terminal device obtains the second license from the second sending unit.

However, Nakahara expressly teaches:

wherein the license management server includes a first sending unit operable to send the first license to the terminal device (Abstract, [0011], [0094], [0099], Figures 1-2, 6, 10, 12-13, 17);

the relay server includes a second sending unit operable to send the second license to the terminal device via the transmission path different from the transmission path in the case of using the license management server (Figure 1), and

the terminal device obtains the second license from the second sending unit ([0011], [0154], [0157], Figure 1, Claims 1-2, 4);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ganesan to include the features of Nakahara because it is common in the related art to employ the use of a system to distribute licenses to a user's terminal device, to consume content.

**As to claim 28:**

Ganesan discloses as discussed above; however, Ganesan does not expressly teach:

further comprising a plurality of servers, one of which is the relay server,

wherein each of the relay servers includes an "n"th license generation unit operable to generate an "n"th ("n" is a natural number that is 2 or greater) license, in an "n"th format, generated by adding, to the first license, the digital signature for detecting the modification of the first license, the "n"th format different from the first format, and

the format conversion unit obtains the "n"th license from one of the relay servers and converts the format of the "n"th license into the first format.

However, Nakahara expressly teaches:

further comprising a plurality of servers, one of which is the relay server (Figure 1),

wherein each of the relay servers includes an "n"th license generation unit operable to generate an "n"th ("n" is a natural number that is 2 or greater) license, in an "n"th format, generated by adding, to the first license, the digital signature for detecting the modification of the first license, the "n"th format different from the first format ([0099], [0101], [0166]-[0167]) and

the format conversion unit obtains the "n"th license from one of the relay servers and converts the format of the "n"th license into the first format (Figures 1, 17-18, 21, 24);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ganesan to include the features of Nakahara because it is common in the related art to employ the use of a system to distribute licenses to a user's terminal device, to consume content.

**As to claim 33:**

Ganesan discloses as discussed above; however, Ganesan does not expressly teach:

wherein the second sending unit sends the second license to the terminal device via a transmission path different from the license management server.

However, Nakahara expressly teaches:

wherein the second sending unit sends the second license to the terminal device via a transmission path different from the license management server ([0011], [0154], [0157], Figure 1, Claims 1-2, 4);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ganesan to include the features of Nakahara because it is common in the related art to distributing content to transmit content on different transmission paths.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-  Lindeman et al., (US 7,370,017); FIG. 2 shows a first example of how a benefit can be bound to content. Package 200 contains both the content 14 and a license 210 to use the content. Exemplary license 210 contains rights 212, which permit a particular entity to use the content in some manner. For example, rights 212 may permit a user 210 to consume the content (e.g., play a video) six times, or for 30 days, or in perpetuity. In this example, the license names the entity 214 to whom the rights apply. In this example, that entity is a person ("Joe"), although it should be understood that content can be licensed to any type of entity (e.g., a group of individuals, a corporation, a department of a larger organization, a particular machine, etc.). Package 200 also contains a cryptographic signature 216, which allows any alteration to package 200 to be detected.

In the example of FIG. 2, the entity 214 to whom license 210 applies may, for example, be user 2 of FIG. 1. That is, user 2 ("Joe", in this example) may have obtained a license for himself to use the content. When user 2 redistributes the content in the hope of making a profit from the redistribution, he transmits to a downstream user (e.g., user 1 of FIG. 1) the entire package 200 containing both his own license and the content. User 1 is not able to use the content based on the license that has been issued to user 2 (other than, perhaps, on a trial basis, such as a single play or a 30-second preview). However, licensor 18 (shown in FIG. 1) can be configured to require that user 1 upload the rights portion of package 200 (including the benefit specification) as a condition for issuing a license for user 1 to consume content 14. (Licensor 18 could also be configured to require that user 1 upload the entire package 200; however, this may be inefficient since it requires a large amount of data to be transferred to the licensee that is not technically necessary in order for the licensing transaction to take place.) Licensor 18 can determine whether any portion of the package has been altered or removed by verifying signature 216. Thus, when user 1 purchases a license for the content, licensor will know that a benefit should be paid to "Joe," since Joe's name appears in license 210 that is transmitted as part of the license request. If Joe's name had somehow been removed from package 200, licensor 18 would be able to detect this removal through verification of signature 216. (Joe may not actually get paid at the time of the licensing transaction; rather, the licensor may log what licensing transactions have taken place and who should be paid, and thus may be able to make these payments intermittently based on the logs.

Mathur et al., (US 6,839,677); Claim 2. The method of claim 1, wherein the method comprises the steps of: sending, with the first data, by the first server to the client browser, a first digital signature for the first server, wherein the transferring of the first digital signature enables the client browser to transfer the first digital signature to the second server and the second server to verify the first digital signature for the first server.

Matsuyama et al., (US 2002/0026581); [0033] Each of the service provider and user devices performing content transaction may have an encryption processing unit. User devices authenticate one another when data are transmitted there between. Subsequently, a data-transmitting user device generates a digital signature to data to be transmitted, and a data-receiving user device verifies the digital signature.

[0045] Each of the service provider and user devices performing content transaction may have an encryption processing unit. Then, the method may further comprise the step in which user devices authenticate one another when data are transmitted there between. Subsequently the step in which a data-transmitting user device generates a digital signature to data to be transmitted and a step in which a data-receiving user device verifies the digital signature.

Hawkins et al., (US 6,389,421); (10) The sequences of operations involved in signature checking, format conversion and watermarking of images in response to end user requests, and delivery of images to an end user both with and without watermarking, will now be described in more detail with reference to FIGS. 2 to 12.

Ramaswamy et al., (US 2006/0242325) Claim 9. A method as defined in claim 1, wherein converting the extracted metadata from the first media format to the second media format to form the converted media information comprises: **generating a watermark based on the second media format; and inserting the watermark in the converted media information.**

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Mr. Dante Ravetti whose telephone number is (571) 270-3609. The examiner can normally be reached on Monday – Thursday 9:00am-5:00pm.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Calvin Hewitt may be reached at (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is (571) 270-4609.

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